

## R E M A R K S

Claims 27 - 29 were pending.

Claims 27 - 74 are pending after entry of the present claim amendments.

Claims 27, 68 and 72 are independent.

## Obviousness-type Double Patenting Rejections

Claims 27 - 29 stand rejected for obviousness-type double patenting in light of U.S. Patent No. 6,381,582. The rejection should be reversed because no prima facie case of obviousness has been made.

Applicable Law

Any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. MPEP 804(II)(B)(1). Thus, the factual inquiries set forth in Graham v. John Deere that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. MPEP 804(II)(B)(1).

The factual inquiries that must be made are:

(A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.

See MPEP 804(II)(B)(1).

When considering whether a claim of an application is an obvious variation of a claim of a patent, the disclosure of the patent may not be used as prior art. MPEP 804(II)(B)(1).

One-way test was not applied

The patent used in the double patenting rejection was filed before the filing date of the present application. Therefore, the "one-way test" is applied. MPEP 804(II)(B)(1)(a).

The one-way test is a determinant of whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim in the patent. MPEP 804(II)(B)(1)(a)

However, here the Examiner has asserted merely that the claims in the patent and the application overlap:

"[T]he only difference [between the issued and pending claim] is the receipt of a code (in the patent) vs the receipt of order data (in [the] application), both pertaining to an order submitted to a remote merchant. Neither the code nor the

order data has been limited to exclude each other. Thus, the order data could include a code, such as an order number. Likewise, the code could include order data, such as the price."

Office Action, pages 2 - 3.

Whether an embodiment might be covered by two claims is irrelevant. The only relevant determination is whether the pending claims would have been obvious in light of the issued claims. This test was not applied, and accordingly a prima facie case of unpatentability has not been made.

#### Claim Limitations Ignored

In addition, in determining the obviousness of a claim, all claim limitations must be considered. Each pending claim includes the following limitations:

certain data is received from a local seller  
and  
there is data indicating that payment has been received by the local seller

Neither limitation has been addressed in the rejection, and neither limitation is recited in issued claim 1.

Further, pending claim 28 includes the following limitation:

the data relating to an order for goods includes at least one of a code and a purchase price

This limitation has not been addressed in the rejection, and is not recited in the issued claim 1.

Further, pending claim 29 includes the following limitation:

the local seller comprises a third party having a contractual relationship with said remote seller

This limitation has not been addressed in the rejection, and is not recited in the issued claim 1.

All the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.

Since these claim limitations have been ignored, a prima facie case of unpatentability has not been made.

#### No motivation to Modify

No motivation to modify the patent is provided at all, much less a motivation which would prompt one of ordinary skill in the art to modify the patented claim to yield

the pending claim. There is only the conclusory statement that the claims are not patentably distinct.

A motivation to modify must be a specific teaching or suggestion in the prior art to combine or modify the references of record. Since there is no motivation to modify the patented claim in a manner which renders the pending claims obvious, a prima facie case of unpatentability has not been made.

#### Drawings

Corrected drawings are submitted herewith.

#### Section 103 Rejections

Claims 27 - 29 stand rejected as obvious in light of U.S. Patent No. 6,029,150 to Kravitz. The rejection should be reversed because no prima facie case of obviousness has been made.

#### Claim Limitations Ignored

All pending claims include the following limitation:

receiving, by said processor from a local seller, data indicating a payment has been received at a point-of-sale system for said order for goods  
and  
transmitting, ... to said remote seller, data indicating that said payment has been received by said local seller ...

The Examiner also admits that these limitations have been ignored, and that Kravitz does not relate to a local seller. The reason provided for ignoring the claim limitation is:

"the present claims do not include any transaction being completed with the local seller, thus little patentable weight is given to the other fields of endeavor in which the payment receiver may be engaged."

This is clearly not a reason to ignore claim limitations when carrying out the required obviousness analysis. Claim limitations may not be ignored. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03.

Further, claim 28 includes the following limitation:

transmitting for use, from said processor to said local seller, at least one of said code and said purchase price

The Examiner fails to address this limitation, and Kravitz does not suggest such a limitation.

Further, claim 29 includes the following limitation:

said local seller comprises a third party having a contractual relationship with said remote seller

The Examiner fails to address this limitation, and Kravitz does not suggest such a limitation.

Since these claim limitations have been ignored, a prima facie case of unpatentability has not been made.

#### No Motivation to Modify

The following motivation to modify Kravitz has been proposed:

"one would have been motivated to use a local merchant as the agent in Kravitz in order to have a ready-made extensive network of agents, thus eliminating the need to set up an additional system of agents throughout the country."

This is generally an allegation that the modification would have been beneficial. However, a motivation to modify only exists where the prior art teaches such a benefit. No evidence has been provided that the prior art would in any way recognize the desirability of such a modification.

Further, with respect to claim 29, the following motivation to modify Kravitz has been proposed:

"in order to have set guidelines, security measures (e.g. encryption), and verification procedures."

No evidence has been provided that the prior art would in any way recognize the desirability of such a modification. In addition, even if the prior art did recognize that it was desirable to "have security measures", this would not prompt one to modify Kravitz to include contractual relationships with the remote seller.

Since there is no motivation to modify Kravitz in a manner which renders the pending claims obvious, a prima facie case of unpatentability has not been made.

#### Newly Added Claims

Newly added Claims 68 - 74 distinguish over the references cited by the Examiner, alone or in combination, for the reasons discussed above with respect to the rejection under Section 103(a).

For example, claims 68 - 71 all include limitations involving two sellers. Kravitz suggests nothing of the sort. Claims 72 - 74 all include limitations involving a step for

determining that the scanned barcode code relates to an order from a different seller, as well as a step for confirming receipt of payment in full for the order.

In particular, new claims 72 - 74 have been added in order to avail Applicants of the benefits of 35 U.S.C. § 112, paragraph six. The remaining claims do not invoke the provisions of 35 U.S.C. § 112, paragraph six.

Conclusion

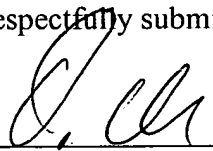
For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

March 19, 2004

Date

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Alderucci', is written over a horizontal line.

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